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EXAMINER

HOUSTON, ELIZABETH

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BARRY WEITZNER

Appeal 2014-010006
Application 12/334,713
Technology Center 3700

Before JILL D. HILL, LISA M. GUIJT, and ERIC C. JESCHKE,
Administrative Patent Judges.

JESCHKE, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Barry Weitzner (“Appellant”) seeks review under 35 U.S.C. § 134(a) of the Examiner’s decision, as set forth in the Final Office Action dated March 13, 2014 (“Final Act.”), and as further explained in the Advisory Action, dated May 2, 2014 (“Adv. Act.”), rejecting claims 1, 3–11, and 13–19.¹ We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Appellant identifies Boston Scientific Scimed, Inc. as the real party in interest. Br. 2.

BACKGROUND

The disclosed subject matter “relates to systems and method for the sealing of a blood vessel, duct, etc.” Spec. ¶ 4, ll. 6–7. Claim 1, the sole independent claim, is reproduced below, with emphasis added:

1. A clip for compressing tissue, comprising:
first and second legs, each extending from a free distal end to a proximal end; and
a joint coupled between proximal ends of the first and second legs and biasing the first and second legs into one of a closed configuration in which the first and second legs are separated from one another by a selected clipping distance and an open configuration in which the first and second legs are separated from one another by a tissue receiving distance greater than the clipping distance, the joint connected to a connection point on each of the first and second legs, the connection point on each of the first and second legs being located at a position such that each leg extends inwardly from the connection point towards an interior of the clip and terminates at a point on the leg indirectly connected to the joint, the first and second legs being shaped so that, when in the closed configuration with no tissue received therebetween, *the first and second legs have a bearing surface extending substantially an entire length of the clip*, a distance between the first and second legs is substantially constant from the joint to the distal ends of the first and second legs, and the free distal end of each of the first and second legs is unconnected to one another.

REJECTIONS

1. Claims 1, 6, 7, and 17–19 stand rejected under 35 U.S.C. § 102(b) as anticipated by Bendel (US 4,449,530, issued May 22, 1984).
2. Claims 3–5, 8–11, and 13–16 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Bendel and Reynolds (US 6,015,417, issued Jan. 18, 2000).

DISCUSSION

Rejection 1 – The rejection of claims 1, 6, 7, and 17–19 under 35 U.S.C. § 102(b)

Appellant argues independent claim 1, and does not separately argue claims 6, 7, and 17–19, which depend from claim 1. Br. 8. Thus, we address only claim 1, with claims 6, 7, and 17–19 standing or falling with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv) (2013). Claim 1 recites a clip, having first and second legs, in which “the first and second legs have a bearing surface extending substantially an entire length of the clip.” Br. 11 (Claims App.).² The Examiner found that Bendel discloses the recited “first and second legs,” and found that “the first and second legs have a bearing surface (the surfaces that bear down on tissue) extending substantially an entire length of the clip (for example, see Figure 5(d)).”³ Final Act. 2.

² We will refer to this as the “limitation at issue.”

³ Although the Examiner identifies leg members 11 and 12 as the “first and second legs” (Final Act. 2; *see also* Bendel, Figs. 1, 3), in light of the citation to Figure 5d, we understand this finding as relying on Figure 5d—showing a portion of leg members 35 and 36 contacting vessel 31—as one demonstration of the recited “bearing surface.” This is further supported by the additional reliance on Figure 3 (which includes leg members 11 and 12) as showing a “bearing surface [that] extends substantially an entire length of the clip.” Final Act. 5 (citing “Figures 3 and 5”).

First, Appellant argues that “Bendel does not describe or suggest a bearing surface length” or “that the bearing surface extends substantially an entire length of the clip.” Br. 4. Appellant notes that Bendel does not indicate that its figures are to scale and argues, quoting section 2125 of the MPEP, that “[w]hen the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value.” *Id.* at 8 (citing *Hockerson-Halberstadt, Inc. v. Avia Grp. Int’l*, 222 F.3d 951, 956 (Fed. Cir. 2000)).

Although Appellant is correct that Bendel does not indicate that its figures are to scale and does not disclose specific numerical values for (1) the length (Y) of thinned portion 13 (*see* Fig. 1), (2) the lengths of the bearing surfaces of the leg members, or (3) the overall length of the clip, for the reasons discussed below, we are not apprised of error in the Examiner’s reliance on Figures 3 and 5 of Bendel to address the limitation at issue. *See* Final Act. 2, 5.

Although patent drawings not designated as drawn to scale should not be relied on for measurements or to define precise proportions of depicted elements if the specification is silent on the issue (*see Hockerson*, 222 F.3d at 956), that does not mean “that things patent drawings show clearly are to be *disregarded*.” *In re Mraz*, 455 F.2d 1069, 1072 (CCPA 1972). Here, we are not apprised of error in the Examiner’s finding that Figures 3 and 5 of Bendel disclose legs with bearing surfaces “extending substantially an entire length of the clip” because figures alone can be relied on for what they disclose with sufficient particularity to one of ordinary skill in the art. *See Mraz*, 455 F.2d at 1072; *see also In re Aslanian*, 590 F.2d 911, 914 (CCPA 1979) (“[A] drawing in a utility patent can be cited against the claims of a

utility patent application even though the feature shown in the drawing was unintended or unexplained in the specification of the reference patent.”).

For example, we agree that Figure 5 discloses with sufficient particularity to one of ordinary skill in the art that the identified bearing surfaces extend substantially the entire length of the clip—i.e., that “the surfaces that bear down on tissue” (Final Act. 2) extend substantially from apex 32 to distal ends 33, 34. *See* Bendel, Fig. 5; *id.*, col. 3, ll. 18–29 (stating that, in Figure 5a, “the clip **30** is placed about a blood vessel **31** with the vessel as close to the apex **32** of the clip as possible” and that Figures 5b–5d show the clip closing such that “the distal ends **33** and **34** of the leg members **35** and **36** start to close to entrap the vessel **31**”).

Second, Appellant contends that “those skilled in the art would conclude that [the bearing surface length in Bendel] does *not* extend substantially an entire length of the clip because the clip 10 of Bendel includes a thinned portion 15 which apparently coincides with the portion of the clip that does not include a bearing surface.” Br. 4–5. According to Appellant, “[t]he pinching motion that the clip 10 of Bendel must utilize to close the legs requires that the thinned portion 15 extends a significant distance from the end of the clip 10” to provide “the desired result shown in Fig. 3.” *Id.* at 5. In addition, Appellant notes that Bendel discloses a variable (Y) for the length of the thinned portion of each leg, and argues that “this variable (although not indicative of an actual distance) indicates that this corresponds to a measurable, significant distance from the hinged portion 13.” *Id.* at 5–6. Appellant also argues that the manufacturing method of Bendel suggests that the bearing surface does not extend the

entire or a substantial length of the clip because “the cutting performed to create the hinged area will always decrease the bearing surface length.” *Id.*

These arguments are not persuasive of error. Here, Appellant does not provide evidence to support the asserted views of one of ordinary skill in the art at the time of the invention. *See In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974) (“Attorney’s argument in a brief cannot take the place of evidence.”). Moreover, even assuming that one of skill in the art *would* have understood that the length (Y) of thinned portion 13 must span a “significant distance” from the hinge portion, Appellant does not explain why that necessarily precludes the identified bearing surfaces from “extending substantially an entire length of the clip,” as required by claim 1. Further, as to the argument that “the cutting performed to create the hinged area will always decrease the bearing surface length,” Appellant does not explain why the bearing surface length would necessarily be decreased by an amount such that it would not “extend substantially an entire length of the clip.”

Third, Appellant contends that the thinned portion of the clip should not be considered part of the “bearing surface” because “the thinned portion of Bendel provides a very specific functionality, none of which includes or is suggestive of being a bearing surface and providing a similar functionality.” Br. 6, 7. This argument does not apprise us of error because Bendel satisfies the limitation at issue without relying on the thinned portion of the clip as part of the identified bearing surface. *See, e.g.*, Final Act. 2 (identifying the “bearing surface” in Figure 5d as “the surfaces that bear down on tissue”).

For these reasons, we sustain the rejection of independent claim 1 as anticipated by Bendel. Claims 6, 7, and 17–19 fall with claim 1.

*Rejection 2 – The rejection of claim 3–5, 8–11,
and 13–16 under 35 U.S.C. § 103(a)*

Appellant argues claims 3–5, 8–11, and 13–16 are patentable because “Reynolds does not disclose or suggest . . . whether the length of the bearing surface extends substantially an entire length of the clip” and “Bendel and Reynolds, taken alone or in combination, do not disclose or suggest the above recitation of claim 1,” from which claims 3–5, 8–11, and 13–16 depend. Br. 8–9. Because we are not apprised of error in the finding that Bendel discloses the feature identified by Appellant (*see supra* Rejection 1), we also sustain the rejection of claims 3–5, 8–11, and 13–16.

DECISION

We AFFIRM the decision to reject claims 1, 6, 7, and 17–19 under 35 U.S.C. § 102(b), and AFFIRM the decision to reject claims 3–5, 8–11, and 13–16 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED